

Remarks/Arguments

The foregoing amendments to the claims are of formal nature, and do not add new matter. Prior to the present amendment, claims 39-51 were pending in this application and were rejected on various grounds. Claim 48 has been canceled without prejudice and claims 39-44 has been amended. The rejection to the presently pending claims are respectfully traversed.

Priority

The Examiner noted that Applicants are entitled to the priority of PCT Application No. PCT/US98/19330, filed 9/16/98 because the subject matter of the present application "is not supported by the US Provisional Application 60/059184 filed 9/17/97.....does not teach how to use instant antibody and thus does not provide an enabling disclosure."

Although the application demonstrated multiple biological activities for the PRO224 polypeptides, for priority purposes, Applicants rely on the result of the '*In vitro* antitumor assay' first disclosed in PCT/US99/28565 filed on 12/2/99, priority to which is claimed in this application. In particular, the data set forth in Example 91, found at page 218 of the present application, demonstrates that, the growth inhibitory effect of the PRO224 polypeptide in the National Cancer Institute's *in vitro* anti-cancer drug discovery screen which has widely and successfully been used to identify anti-cancer agents since its establishment in the early 1990s, shows 50% neoplastic cell growth inhibition at one or more concentrations in many cell lines including ovarian, renal, prostate, non-small cell lung carcinoma (NSCL), melanoma, leukemic, CNS, breast, colon cells (see Table 7). Thus, PRO224 is therapeutically useful. Accordingly, the effective filing date of the present application is December 2, 1999.

Specification

The specification has been objected to for containing an embedded hyperlink. The foregoing amendment, which deleted all embedded hyperlinks or other forms of browser executable code, is believed to overcome this objection.

Claim Rejections – 35 USC § 112/Enablement

Claims 39-51 were rejected under 35 U.S.C. §112, first paragraph, "because the specification does not reasonably provide enablement for: an isolated protein not identical to at least the mature form of SEQ ID NO:127 which does not have the instant activities".

Applicants submit that the specification discloses a substantial, specific and credible utility for the PRO224 polypeptides in the *in vitro* anti-tumor assay data. This specific utility is now recited in the rejected claims by reciting that the PRO224 polypeptides is "capable of inhibiting neoplastic cell growth." Therefore, the claims are no longer drawn to a genus of polypeptides defined by sequence identity alone, but instead, are defined by functional identity as well. Based on the information disclosed in the specification and available in the art, one skilled in the art knew how to practice the claimed invention, at the effective priority date of this application, without undue experimentation. As the M.P.E.P. states, "The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-charge cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'. sub nom.*, *Massachusetts Institute of Technology v A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985) M.P.E.P. 2164.01.

Accordingly, the present rejection is believed to be moot, and should be withdrawn.

35 USC § 112, First Paragraph/Written Description

Claims 39-51 were rejected under 35 U.S.C. §112, first paragraph, as allegedly, the specification does not convey to one skilled in the art that the inventors possessed the claimed invention. Applicants respectfully traverse.

Again, a specific utility is now recited in the rejected claims by reciting the requirement that the PRO224 polypeptides are "capable of inhibiting neoplastic cell growth." Since the claims are now drawn to a genus of polypeptides defined by sequence and functional identity as well, one skilled in the art knew at the effective priority date of this application, that the Applicants possessed the claimed sequences.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of all pending claims under this section.

35 USC § 112, Second Paragraph

Claims 39-51 were rejected under 35 U.S.C. §112, second paragraph, allegedly, as being indefinite for reciting "the polypeptide...lacking its associated signal peptide" and "the extracellular domain...lacking its associated signal sequence, parts (b) and (d)."

The foregoing amendments wherein such references have been deleted in the above claims are believed to overcome this rejection.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No.: 39780-1618P2C13). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

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